

Attorney's Docket No.:06816-073003

REMARKS

Reconsideration and allowance of the above referenced application are respectfully requested.

Claims 3, 8, 9, 14-17 and 20 stand rejected under 35 USC 103 as allegedly being unpatentable over Harada in view of Prakash, et al. and Narayanan. This contention is respectfully traversed, and it is respectfully suggested that the rejection does not meet the patent office's burden of providing a prima facie showing of unpatentability. Initially, with regard to the patent office's statement in response to arguments, it should be noted that simply because a reference does not exclude something does not make it obvious. The fact that a material would inherently have an effect does not make it obvious to use that material for that effect in some other reference. In fact, this whole combination is based on hindsight, not on the present specification.

Claim 3 requires forming the membrane electrode assembly using a solid electrolyte membrane, and pretreating that membrane with a pretreating agent that reduces wrinkling of the membrane when catalyst is applied. The rejection relies on a hypothetical combination of Harada which shows forming a membrane assembly, along with Prakash which teaches swelling the membrane (column 12 lines 33-35,) and Narayanan which teaches

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soaking the membrane in water or in a mixture of isopropanol and water for a soaking time, prior to transferring a decal of catalyst. Importantly, none of these references, even if combined, teach or suggest the claimed subject matter that the pretreating agent "reduces wrinkling of the membrane when catalyst is applied". None of these references teach or suggest anything about reducing wrinkling.

Prakash admittedly teaches swelling the membrane. It teaches nothing about doing this to reduce wrinkling. A person having ordinary skill in the art is left to contemplate why one might swell the membrane, but in any case there is no guidance to reduce wrinkling as defined by claim 3.

Narayanan is a very different kind of system than claim 3, since it requires that a decal of catalyst be formed and transferred. There is no teaching or suggestion of wrinkling, or prevention of wrinkling. Moreover, the concepts described in Narayanan, requiring a decal, are very different than those of the present system.

Therefore, claim 3 should be allowable along with the claims that depend therefrom.

Applicant asks that all claims be allowed. It is believed

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no fee is due, however, please apply any other charges or
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Respectfully submitted,

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